REMARKS

Claims 2, 4, 5, 7-10, 13-16, 19-29, and 35-72 were pending in the Application before entrance of the present Amendment. Claims 7-10, 13, 15, 16, 36-38, 50-64, and 67-72 were withdrawn from consideration by the Examiner at this time, and claims 1, 3, 6, 11, 12, 17, 18, and 30-34 were cancelled. By the present Amendment, claims 7-10, 13, 15, 16, 50-64, and 67-72 are canceled, and claims 2, 4, 5, 39, 41, 43, 45-48, 65 and 66 are currently amended. No new matter has been added to the Application by this Amendment. After entrance of the present Amendment, claims 2, 4, 5, 14, 19-29, 35-49, 65, and 66 are pending and under consideration by the Examiner.

Each of the rejections levied by the Examiner in the Office Action is addressed in turn below.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 2, 4, 5, 14, 19-29, 35, 39, 40-49, 65, and 66 stand rejected under 35 U.S.C. § 112, first paragraph. The Examiner asserts that the specification, while being enabling for some of the claimed compounds, does not reasonably provide enablement for the full scope of the claims. The Examiner alleges that "[t]he specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims." Applicant respectfully disagrees.

The specification enables one of ordinary skill in the art to make the claimed compounds.

Applicant believes the amended claims are enabled. Upon review of the Reaction Schemes I-X (on pages 74-104) and the representative 167 synthetic examples (on pages 110-166) of the specification, one of ordinary skill in the art could make the claimed compounds without undue experimentation.

The specification enables the use of the claimed compounds.

Applicant submits that the claimed invention is enabled. Section 2164.01(c) of the MPEP entitled "*How to Use the Claimed Invention*" sets forth the requirements for enabling the use of the claimed invention:

> "If a statement of utility in the specification contains within it a connotation of how to use, and/or the art recognizes that standard modes of administration are known and contemplated, 35 U.S.C. 112 is satisfied. *In re Johnson*, 282 F.2d 370, 373, 127 USPQ 216, 219 (CCPA 1960); *In re Hitchings*, 342 F.2d 80, 87, 144 USPQ 637, 643 (CCPA 1965). See also *In re Brana,* 51 F.2d 1560, 1566, 34 USPQ2d 1437, 1441 (Fed. Cir. 1993).
>
> "[W]hen a compound or composition claim is not limited by a recited use, any enabled use that would reasonably correlate with the entire scope of that claim is sufficient to preclude a rejection for non-enablement based on how to use."

The Application, as filed, teaches one of ordinary skill in the art how to use the claimed compounds. The specification discloses that the claimed compounds "are useful in inducing cytokine biosynthesis in animals" (page 1, lines 29-30, of the published international PCT application no. WO 2005/048945). The Application also teaches experimental procedures for inducing cytokine biosynthesis in human cells on page 166, line 6, through page 168, line 14. Therefore, the requirement for enabling the use of the claimed compounds under § 112 is satisfied. The Examiner has not provided any evidence that the claimed compounds could not be used for the stated purpose. Applicant therefore respectfully requests the removal of this rejection.

Rejections under 35 U.S.C. § 103

The Examiner has also rejected claims 2, 4, 5, 14, 19-29, 35, 39, 40-49, 65, and 66 under 35 U.S.C. § 103(a) as being obvious over WO 2005/018556, WO 2005/018551, WO 2005/048933, and WO 2005/051324. (Note – The Examiner actually cited "WO 2005/01551." Applicant assumes that the Examiner intended to cite WO 2005/01**8**551.) The Examiner has cited WO 2005/018556, WO 2005/018551, WO 2005/048933, and WO 2005/051324 as prior art under § 102(e) against the present Application. With respect to WO 2005/018556, WO 2005/018551, WO 2005/048933, and WO 2005/051324, Applicant submits herewith Declarations under 37 CFR § 1.132 evidencing that the inventions described in these publications were not invented "by another" as required by § 102(e) to constitute prior art. WO 2005/018556, WO 2005/018551, WO 2005/048933, and WO 2005/051324 are not prior art under § 102(e), and therefore, these publications are not prior art citable against the present Application under § 103. Applicant respectfully requests that this rejection be removed.

Double Patenting Rejection

The Examiner provisionally rejected claims 2, 4, 5, 14, 19-29, 35, 39, 40-49, 65, and 66 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-25 of U.S. Patent Application, Serial No.: 11/595,058 (the '058 application). Applicant defers discussion of this provisional rejection until it matures into an actual rejection.

The Examiner provisionally rejected claims 2, 4, 5, 14, 19-29, 35, 39, 40-49, 65, and 66 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 18 and 31 of copending U.S. Patent Application, Serial No.: 11/595,065 (the '065 application) in view of the published international PCT application no. WO 2005/051324. Applicant defers commenting on this provisional rejection until it matures into an actual rejection.

The Examiner provisionally rejected claims 2, 4, 5, 14, 19-29, 35, 39, 40-49, 65, and 66 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claim 1 of the '058 application, in view of claim 1 of co-pending U.S. Patent Application, Serial No.: 11/884,153 (the '153 application) and claim 1 of co-pending U.S. Patent Application serial No.: 10/595,792 (the '792 application). Applicant defers discussion of this provisional rejection until it matures into an actual rejection.

Applicant believes no fee is due. However, if an additional fee is due, please charge our Deposit Account No. 23/2825, under Docket No. C1271.70032US01, from which the undersigned is authorized to draw.

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Respectfully submitted,

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